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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,857	10/31/2003	Paul B. Ramsay	1517.007US1	9338

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

SORKIN, DAVID L

ART UNIT PAPER NUMBER

1723

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,857

Applicant(s)

RAMSAY, PAUL B.

Examiner

David L. Sorkin

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1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-9,13-17 and 21-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-9, 13-17 and 21-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4-9, 13-17 and 21-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schellenger (US 2,022,481) in view of Miller et al. (US 2,590,442). Schellenger ('481) discloses a paint circulation system comprising a paint supply station (1), paint supply channel (9) having a number of supply nodes (see Fig. 2); a paint return channel (18) upstream of the and paint supply station, the paint return channel having a number of nodes (see Fig. 2); a plurality of paint circulation lines (23,24) including drop lines downstream of the supply channel at a corresponding supply node and upstream of the return channel at a corresponding return node, each of the drop lines (23,24) having a paint output nozzle assembly including a paint spray gun (25,26) and control means (33,34,35,36). Coiled tubing is not disclosed. Miller ('442) discloses coiled tubing (18). It would have been obvious to one of ordinary skill in the art to have provided the drop lines of Schellenger ('481) with coils as taught by Milller ('442) to achieve the advantage of heating the paint, thereby lowering viscosity and saving time, reducing thinner consumption and improving quality (See col. 1 lines 1-22). As seen in Fig. 2, several manual flow through regulator valves such as 34 and 35 are disclosed. It would have been obvious to one of ordinary skill in the art to have made the tubing of

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stainless steel to prevent corrosion. The decisions *In re Rose* 105 USPQ 237 (CCPA 1955) and *Gardner v. TEC Systems, Inc.* 220 USPQ 777 (Fed. Cir. 1984) are relied upon concerning the obviousness of selecting a size.

Response to Arguments

3. In accordance with applicant's remarks, this action has not been made final.

4. While the examiner agrees that Schellenger ('481) does not disclose the claimed coil tube, the examiner maintains that Miller ('442) disclose a coiled tube in accordance with the respective independent claims. With respect to an apparatus claim, a prior art need not disclose an intend use of the apparatus or an element thereof, to anticipated the claim limitation. In other words, "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey*, 152 USPQ 235 (CCPA 1967) and "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Regarding the intended use of the tubing "for developing a differential pressure in a paint circulation line", while this intended use is not germane to patentability, as held in the above decisions, it is an inherent capability of any tube, whether coiled or straight or otherwise to provide a pressure drop. Without a pressure drop across a portion of tubing, there would be no flow.

5. Applicant discusses a recitation of "means for generating differential pressure...". It is considered that a coiled tube is a corresponding structure with respect to the function of this means plus function recitation, which Miller ('442) discloses. Applicant

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states "The examiner has not provided an explanation or a rationale as to why either Schellenger and [sic or] Miller shows an equivalent to the corresponding elements".

However, Miller discloses the corresponding structure itself (a coiled tube) rather than an equivalent of the corresponding structure. Applicant is advised that MPEP 2181 states that "the phrase 'means for' or 'step for' must not be modified by sufficient structure, material or acts for achieving the specified function" for it to be considered that section 112 sixth paragraph is invoked. In the instance case, the structure "coiled tubing" is sufficient structure for achieving the specified function.

6. Applicant's statement regarding use of an embodiment of the invention in the United States is acknowledged.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 571-272-1148. The examiner can normally be reached on 9:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


David L. Sorkin
Primary Examiner
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DLS